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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,567	03/28/2005	Michael Primavera	2864 (203-3484)	9155
50855	7590	08/05/2008		
Tyco Healthcare Group LP 60 MIDDLETOWN AVENUE NORTH HAVEN, CT 06473			EXAMINER DANG, PHONG SON H	
			ART UNIT	PAPER NUMBER
			4166	
			MAIL DATE	DELIVERY MODE
			08/05/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,567	Applicant(s) PRIMAVERA ET AL.	
	Examiner SON DANG	Art Unit 4166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/28/2005, 10/27/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of Species I, Fig. 1-7, Claims 1-16 and 22 in the reply filed on 07/09/2008 is acknowledged.
2. Claims 17-21 are withdrawn from further consideration pursuant to 37CFR 1.142 (b) as being drawn to a non elected invention, there being no allowable generic or linking claim. Election was made without traverse in a reply filed on 07/07/2008.

Drawings

3. Figure 2-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 14, which depends on Claim 11, is claiming the scale that is etched into the elongate member, but claim 11 claimed that the scale is provided on a material affixed to the elongate member. It is not clear how the scale is being applied to the elongate member since one of ordinary skill in the art would know that you do not use affixed material and etched scale together on the same elongate member. For purposes of a prior art rejection, claim 14 has been reinterpreted to depend directly from claim 1 and not claim 11.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1-10, 14-16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,478,344 to Stone et al. (Stone) in view of US Patent No. 5,665,093 to Atkins et al. (Atkins).

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In Reference to Claim 1:

Stone teaches:

A surgical instrument for manipulating a needle and suture comprising:

An elongate member (3 Fig. 1, Col. 3, line 37) having a distal end configured to manipulate a needle and suture (Fig. 1); a predetermined point on the elongate member (at the pivot joint for the jaws).

Stone fails to teach:

A scale on at least a part of the elongate member and extending from the distal end, the scale having at least one graduation; and a predetermined point on the elongate member, wherein the scale indicates the distance from the predetermined point to the at least one graduation.

Atkins teaches:

A scale (60, Fig. 9, Col. 2, lines 1-3, Col. 4, lines 7-10) on at least a part of the elongate member (22, Fig. 9, Col. 3, line 25) and extending from the distal end, the scale (60, Fig. 9, Col. 2, lines 1-3, Col. 4, lines 7-10) having at least one graduation (Fig. 9); and a predetermined point (34, Fig. 9, Col. 3, lines 35) on the elongate member (22, Fig. 9, Col. 3, line 25), wherein the scale (60, Fig. 9, Col. 2, lines 1-3, Col. 4, lines 7-10) indicates the distance from the predetermined point to the at least one graduation (Fig. 9).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the teaching of Atkins with Stone to produce a device having

a scale with graduation on its tubular body for measuring purposes to facilitate surgery (see Atkins, Col. 4, lines 7-10).

In Reference to Claim 2:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 1 above), wherein the elongate member (3 Fig. 1, Col. 3, line 37) includes at least one jaw (5, Fig. 1) and the predetermined point (15, Fig. 1, Col. 3, lines 53-54) is disposed on the jaw.

In Reference to Claim 3:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 2 (see rejection of Claim 2 above), wherein the at least one jaw (5, Fig. 1) has a recess (15, Fig. 1, Col. 3, lines 53-54) configured to retain a needle carrying a suture and the predetermined point is located on the needle (Fig. 7, where the suture 18 goes into needle 14).

In Reference to Claim 4:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 2 (see rejection of Claim 2 above), wherein the at least one jaw (5, Fig. 1) has a recess configured to retain a needle carrying a suture (15, Fig. 1, Col. 3, lines 53-54), and the predetermined point is located at a point of connection

between the suture and the needle (66, Fig. 8).

In Reference to Claim 5:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 4 (see rejection of Claim 4 above), wherein the point of connection is at one end (66, Fig. 8, Col. 5, lines 4-5) of the needle.

In Reference to Claim 6:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 4 (see rejection of Claim 4 above), wherein the point of connection is located between (66, Fig. 8) the ends of the needle.

In Reference to Claim 7:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 2 (see rejection of Claim 2 above), wherein the at least one jaw (5, Fig. 1) is movable relative to the elongate member (3, Fig. 1), wherein the distance from the predetermined point (66, Fig. 8) and the scale is calibrated with the at least one movable jaw (5, Fig. 1) in a predetermined position. (After putting the scale from Atkins on the tubular member (3, Fig. 1) of Stone, you would consequently have the predetermined position in at least one movable jaw)

In Reference to Claim 8:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 7 (see rejection of Claim 7 above), wherein elongate member includes two movable jaws (4, 5, Fig. 1).

In Reference to Claim 9:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 8 (see rejection of Claim 8 above), wherein the two movable jaws (4, 5, Fig. 10) are configured to pass a needle carrying a suture there between.

In Reference to Claim 10:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 1 above), wherein the scale includes a plurality of graduations (Fig. 9 from Atkins).

In Reference to Claim 14:

Examiner understands that claim 14 should have depended directly from claim 1 and not by way of claim 11.

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of

Claim 1 above), wherein the scale is etched (Atkins, Col. 2, lines 1-3) into the elongate member.

In Reference to Claim 15:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 15 above), wherein the at least one graduation indicates the distance in centimeters (Col. 2, lines 1-3).

In Reference to Claim 16:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 1 above), wherein the at least one jaw (4, Fig. 1) is configured for grasping a needle carrying a suture.

In Reference to Claim 22:

Stone teaches:

In a surgical suturing apparatus including an elongate member (3, Fig. 1) having a proximal end and a distal end and a longitudinal axis; a pair of jaws (4, 5, Fig. 1) at the distal end, at least one of the pair of jaws being movable (Fig. 1), the pair of jaws (4, 5, Fig. 1) each having a recess (15, Fig. 9, Col. 3, lines 53-54) for receiving a suture carrying needle; needle retaining structure (15, Fig. 9) in each jaw of the pair of jaws, the

needle retaining structure extending from the respective jaw toward the proximal end (Fig. 9); and a handle (2, Fig. 1, Col. 3, lines 28) at the proximal end including structure for alternately advancing and retracting the needle retaining structure the improvement (Col. 4, lines 38-60).

Stone fails to teach:

A scale defined on the elongate member, the scale extending along the longitudinal axis of the elongate member and having graduations for measuring the length of the suture.

Atkins teaches:

A scale (60, Fig. 9, Col. 2, lines 1-3, Col. 4, lines 7-10) defined on the elongate member (22, Fig. 9, Col. 3, line 25), the scale (60, Fig. 9, Col. 2, lines 1-3, Col. 4, lines 7-10) extending along the longitudinal axis of the elongate member (22, Fig. 9, Col. 3, line 25) and having graduations (Fig. 9) for measuring the length of the suture.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the teaching of Atkins with Stone to produce a device having a scale with graduation on its tubular body for the same reasons as noted in claim 1 above.

9. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone in view of Atkins as applied to claim 1 and further in view of US Patent No. 5,237,985 to Hodgson et al. (Hodgson).

In Reference to Claim 11:

Stone as modified by Atkins teaches:

The surgical instrument as recited in claim 1 (see rejection of Claim 1 above).

Stone as modified by Atkins fails to teach:

The instrument having a scale provided on a material affixed to the elongate member.

Hodgson teaches:

The instrument having a scale (Fig. 12, Col. 10, lines 29-35) provided on a material affixed to the elongate member (shrink warp scale 184 on Fig. 12).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have substituted the shrink wrapped scale of Hodgson in place of the scale of Stone as modified by Atkins because such a modification would have been considered a mere substitution of art-recognized scales.

In Reference to Claim 12:

Stone as modified by Atkins and Hodgson teaches:

The surgical instrument as recited in claim 11 (see rejection of Claim 11 above), wherein the scale is located on shrink wrap affixed to the elongate member (184, Fig. 12, Col. 10, lines 29-35).

In Reference to Claim 13:

Stone as modified by Atkins and Hodgson teaches:

The surgical instrument as recited in claim 11 (see rejection of Claim 11 above), wherein the scale is located on at least one longitudinally extending strip of material (Fig. 12, Col. 10, lines 29-35).

CONCLUSION

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Chapman US Patent NO 5,122,146 teaches a device for reducing fracture having a scale with graduation in centimeter.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SON DANG whose telephone number is (571)270-5809. The examiner can normally be reached on Monday-Friday 7:30 AM - 5:00 PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ken Bomberg can be reached on 571-272-4922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SD

/Kenneth Bomberg/
Supervisory Patent Examiner, Art Unit 4166